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EXAMINER

BILGRAMI, ASGHAR H

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/868,029	Applicant(s) MIYAZAKI ET AL.	
	Examiner ASGHAR BILGRAMI	Art Unit 2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-15, 17-31, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-15, 17-31, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-10, 15, 17-26, 31, 36 & 37 rejected under 35 U.S.C. 103(a) as being unpatentable over Tokyo Shibaura Electric Co et al (9-179594) {submitted as IDS} and Cartmell (60,36,068).

3. As per claims 36 Tokyo Shibaura Electric Co disclosed a handheld {Due to its size it can fit in pocket therefore it is considered to be a handheld device, please see figure 2 on page 8 of the foreign reference} recording and/or reproducing device (Figure 1, page 8 of the foreign reference and page.8 ,paragraph.9 of disclosure document 9-179594) , comprising: a housing case having one side opposite an other end side (Drawing 2 shows the housing case of the handheld device); a manipulating unit (Drawing 2, element 14 of the foreign reference & Page.13, Paragraph.25 of disclosure document 9-179594) configured to be arranged on a plane perpendicular to a longitudinal direction of said housing case at the one end side {Examiner notes that this added limitation merely describes the “design choice” and has no impact on the functionality of the claimed invention}; a jack configured to be arranged at one end side ((Tokyo Shibaura Electric Co, page 15, Paragraph.34 of disclosure document 9-179594,

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lines 13-15), said jack having a opening arranged to receive a plug inserted from a direction of the one end side {Tokyo Shibaura Electric Co, page 15, Paragraph.34 of disclosure document 9-179594, lines 13-15, it is well known that a jack is supposed to have some kind of plug to be inserted in it (for example ear phone)); a storage medium configured to store digital data (page.10 , Paragrpah.14 of disclosure document 9-179594); a reproducing unit (page 16, paragraph.37 of disclosure document 9-179594); a power supply unit configured to contain a power supply and to be arranged at the other end side of the housing case, wherein , when the power supply is within the power supply unit, a center of gravity of the device is substantially at the other end side in the longitudinal direction of the housing case (Page 15, paragraph.34 , lines 16 & 17 of disclosure document 9-179594) ; and a control unit configured to control said reproducing unit to reproduce the stored digital data in accordance with an input from said manipulating unit (Page16, Paragraphs.37 & 38 of disclosure document 9-179594), said housing case containing said storage medium , said control unit, said reproducing unit (Page.15, Paragraph.34 of disclosure document 9-179549 & figure 1), said Power supply unit, and said jack configured to output an audio signal generated by said reproducing unit ({Tokyo Shibaura Electric Co, page 15, Paragraph.34 of disclosure document 9-179594). However Tokyo Shibaura Electric Co did not explicitly disclose a strap attaching unit configured to be arranged at the one end side, wherein the strap attaching unit is at a predetermined position spaced from the manipulating unit in a direction of the other end side and the predetermined position of the strap attaching unit is spaced from the center of gravity of the device in a direction of the one side end,

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so as to orient the manipulating unit in a predetermined direction when the device is supported at the strap attaching unit from a direction of the one end side.

In the same field of endeavor Cartmell disclosed a strap attaching unit configured to be arranged at the one end side, wherein the strap attaching unit is at a predetermined position spaced from the manipulating unit in a direction of the other end side and the predetermined position of the strap attaching unit is spaced from the center of gravity of the device in a direction of the one side end, so as to orient the manipulating unit in a predetermined direction {I.E in downward direction due to the weight of the device with respect to its center of gravity and the nature of the gravity pull (See figure 2)} when the device is supported at the strap attaching unit from a direction of the one end side {Figure 2, element 34 (strap/lanyard) attached to element 40 (any device) , col.4, lines 4-10 and col.5, lines 11-27)}.

It would have been obvious to one in the ordinary skill in the art at the time the invention was made to have incorporated a strap attaching means as disclosed by Cartmell onto a portable recording and/or reproducing device disclosed by Tokyo Shibaura Electric Co in order to make the device more easier to carry by an individual resulting in improving the portability aspect of the device by a user.

{Additionally examiner notes that the limitation W.R.T location of power supply merely describes the location where power supply unit is located on the body of the handheld recording and/or reproducing device which is merely a design choice and it does not alter the functionality of the invention being claimed. In light of this limitation examiner additionally cites KSR which states:

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The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson 's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

Hence this limitation is anticipated by the prior arts}.

4. As per claims 2, 17 and 20 Tokyo Shibaura Electric Co -- Cartmell disclosed the handheld recording and/or reproducing device according to Claim 36, comprising: digital-to-analog converting means for producing an analog signal by digital-to-analog converting said digital data which has been subjected to the reproduction processing by said reproducing unit (Tokyo Shibaura Electric Co, page 15, Paragraph.34 of disclosure document 9-179594 & figure 5 of the foreign reference) ; and said jack is provided on the one end side in said longitudinal direction of said case having a terminal for outputting said analog signal obtained from said digital-to-analog converting means to said connection plug inserted (Tokyo Shibaura Electric Co, page 15, Paragraph.34 of disclosure document 9-179594, lines 13-15), and wherein said strap has a ring part {Figure 2, element 34 (strap/lanyard) attached to element 40 (any device) , col.4, lines 4-10 and col.5, lines 11-27}} and a holding means for integrally holding a code

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introduced from said connection plug and said ring part (Tokyo Shibaura Electric Co, (Page16, Paragraphs.37 & 38 of disclosure document 9-179594).

5. As per claims 3 & 21 Tokyo Shibaura Electric Co - Cartmell disclosed the handheld recording and/or reproducing device according to Claim 2, wherein said jack is provided in said case so that said plug is projected from the other end side toward the one end side in said longitudinal direction (Tokyo Shibaura Electric Co, Page16, Paragraphs.37 & 38 of disclosure document 9-179594).

6. As per claims 4 & 22 Mills- Cartmell disclosed the handheld recording and/or reproducing device according to Claim 3, wherein said jack is provided so that the direction of inserting said connection plug is slant with respect to said longitudinal direction of said case (Tokyo Shibaura Electric Co, Page16, Paragraphs.37 & 38 of disclosure document 9-179594).

7. As per claim 5 Tokyo Shibaura Electric Co - Cartmell disclosed the handheld recording and/or reproducing device according to Claim 36 (Tokyo Shibaura Electric Co, Page16, Paragraphs.37 & 38 of disclosure document 9-179594), further comprising strap attaching means which is provided on said one end side in the longitudinal direction of said case for attaching a predetermined strap thereto {Figure 2, element 34 (strap/lanyard) attached to element 40 (any device) , col.4, lines 4-10 and col.5, lines 11-27}}.

8. As per claim 6 Tokyo Shibaura Electric Co - Cartmell disclosed the recording and/or reproducing device according to Claim 5 (Tokyo Shibaura Electric Co, Page16, Paragraphs.37 & 38 of disclosure document 9-179594), wherein said strap attaching means allows said dangling strap to be attached thereto {Figure 2, element 34 (strap/lanyard) attached to element 40 (any device), col.4, lines 4-10 and col.5, lines 11-27}}.

9. As per claims 7 & 23 Tokyo Shibaura Electric Co - Cartmell disclosed the portable recording and/or reproducing device according to Claim 36, further comprising: a circuit board which is contained in said case with loading an Integrated Circuit package (Tokyo Shibaura Electric Co, Page16, Paragraphs.37 & 38 of disclosure document 9-179594) which constitutes at least a part of said control means; and projecting parts for containing a part of said circuit board, which are formed so that a part of said case projects in accordance with the form of said circuit board (Tokyo Shibaura Electric Co, Page11, Paragraphs.18 of disclosure document 9-179594).

10. As per claims 8 & 24 Tokyo Shibaura Electric Co - Cartmell disclosed the handheld recording and/or reproducing device according to Claim 7, wherein said projecting parts are formed in said longitudinal direction of said case (Tokyo Shibaura Electric Co, Figure 1, page 8 of the foreign reference and page.8 ,paragraph.9 of

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disclosure document 9-179594).

11. As per claims 9 & 25 Tokyo Shibaura Electric Co - Cartmell disclosed the handheld recording and/or reproducing device according to Claim 36, further comprising a clip which is provided on said one end side in said longitudinal direction of said case to attach the case to a user's body, clothes, and belongings (Tokyo Shibaura Electric Co, Figure 1, page 8 of the foreign reference)

12. As per claims 10 & 26 Tokyo Shibaura Electric Co- Cartmell disclosed the handheld recording and/or reproducing device according to Claim 36, further comprising: an interface for taking in said digital data which is transferred from outside; and recording means for recording said digital data taken in by said interface, to said recording medium (Tokyo Shibaura Electric Co, Figure 1, page 8 of the foreign reference and page.8, paragraph.9 of disclosure document 9-179594).

13. As per claims 15 & 31 Tokyo Shibaura Electric Co - Cartmell disclosed the handheld recording and/or reproducing device according to Claim 36, wherein said case is formed in a cylindrical form (Tokyo Shibaura Electric Co, Page.15, Paragraph.34 of disclosure document 9-179549 & figure 1).

14. As per claim 18 Tokyo Shibaura Electric Co- Cartmell disclosed the handheld recording and/or reproducing device according to Claim 17, wherein said ring part

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comprises: band member; and sticking means for sticking one end on the back plane of said band member to the other end on the front plane of the band member {Figure 2, element 34 (strap/lanyard) attached to element 40 (any device) , col.4, lines 4-10 and col.5, lines 11-27}}.

15. As per claim 19 Tokyo Shibaura Electric Co- Cartmell disclosed the handheld recording and/or reproducing device according to Claim 18, wherein said sticking means is a sticking tape for detachably sticking said one end on said back plane of said band member to said the other end on said front plane of the band member {Figure 2, element 34 (strap/lanyard) attached to element 40 (any device) , col.4, lines 4-10 and col.5, lines 11-27}}.

16. As per claim 37 Tokyo Shibaura Electric Co- Cartmell disclosed the handheld recording and/or reproducing device according to Claim 36, further comprising: a strap to be attached to said strap attaching unit {Figure 2, element 34 (strap/lanyard) attached to element 40 (any device) , col.4, lines 4-10 and col.5, lines 11-27}}.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 11, 12, 13, 14, 27, 28, 29 & 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tokyo Shibaura Electric Co** et al (9-179594) {submitted as IDS}, **Cartmell** (60,36,068) and **Mills** (U.S 6,353,870).

19. As per claims 11 & 27 **Tokyo Shibaura Electric Co - Cartmell** disclosed the handheld recording and/or reproducing device according to Claim 10. However neither Tokyo Shibaura Electric Co nor Cartmell explicitly disclose wherein said interface takes in said digital data which is transferred from said outside on Internet. In the same filed of endeavor **Mills (U.S 6,353,870)** disclosed wherein said interface takes in said digital data which is transferred from said outside on Internet (Mills, col.11, lines 9-11).

It would have been obvious to one in the ordinary skill in the art at the time the invention was made to have incorporated the functionality of transferring digital data from the internet as disclosed by Mills on the portable recording and/or reproducing device disclosed by Tokyo Shibaura Electric Co and Cartmell in order to make the device more versatile resulting in acquiring recording and playback data capability from additional venues.

20. As per claims 12 & 28 **Tokyo Shibaura Electric Co - Cartmell** disclosed the handheld recording and/or reproducing device according to Claim 11. However neither Tokyo Shibaura Electric Co nor Cartmell explicitly disclose wherein said interface is a

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connector based on the Universal Serial Bus standard. In the same filed of endeavor

Mills disclosed wherein said interface is a connector based on the Universal Serial Bus standard (Mills, col.5, lines 59-67).

It would have been obvious to one in the ordinary skill in the art at the time the invention was made to have incorporated USB connector as disclosed by Mills on the portable recording and/or reproducing device disclosed by Tokyo Shibaura Electric Co and Cartmell in order to make the device more versatile resulting in acquiring recording and playback data capability from additional venues.

21. As per claims 13 & 29 **Tokyo Shibaura Electric Co - Cartmell** disclosed the handheld recording and/or reproducing device according to Claim 36. However neither Tokyo Shibaura Electric Co nor Cartmell explicitly disclose wherein said control means read out said digital data which has been compressed with the MPEG Audio Layer-3 method, from said recording medium, in accordance with said reproduction instruction input with said manipulating means. In the same filed of endeavor **Mills** disclosed wherein said control means read out said digital data which has been compressed with the MPEG Audio Layer-3 method, from said recording medium, in accordance with said reproduction instruction input with said manipulating means (Mills, col.7, lines 65-67 & col.8, lines 1-13).

It would have been obvious to one in the ordinary skill in the art at the time the invention was made to have incorporated MPEG Audio Layer -3 {A.K.A MP3} capability as disclosed by Mills on the portable recording and/or reproducing device disclosed by

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Tokyo Shibaura Electric Co and Cartmell in order to make the device more versatile resulting in recording and playback data capability in additional formats.

22. As per claims 14 & 30 **Tokyo Shibaura Electric Co - Cartmell** disclosed the handheld recording and/or reproducing device according to Claim 36. However neither Tokyo Shibaura Electric Co nor Cartmell explicitly disclosed wherein said control means reads out said digital data which has been compressed by the Adaptive Transform Acoustic Coding-3 method, from said recording medium, in accordance with said reproduction instruction input with said manipulating means. In the same filed of endeavor **Mills** disclosed wherein said control means reads out said digital data which has been compressed by the Adaptive Transform Acoustic Coding-3 method, from said recording medium, in accordance with said reproduction instruction input with said manipulating means (Mills, col.3, lines 10-25).

It would have been obvious to one in the ordinary skill in the art at the time the invention was made to have incorporated data which being compressed by the Adaptive Transform Acoustic Coding-3 method as disclosed by Mills on the portable recording and/or reproducing device disclosed by Tokyo Shibaura Electric Co and Cartmell in order to make the device more versatile resulting in recording and playback data capability in additional formats.

Response to Arguments

Applicant's arguments with respect to claim 2-10, 15, 17-26, 31 and 36- 37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

23. In addition to the prior art made of record in the past prosecution history of this case, the following are the newly added prior arts made of record and not relied upon is considered pertinent to applicant's disclosure.

24. Wyzykowski (U.S. 5,548,227) disclosed personal carrier for partially consumed confections.

25. Leary (U.S. 4,951,691) disclosed method of treating and curing smoking hobbits and the like in adults.

26. Robertson (U.S. 5,230,649) disclosed Duck Call Apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASGHAR BILGRAMI whose telephone number is (571)272-3907. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia L.M. Dollinger can be reached on 571-272-4170. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. B./

Examiner, Art Unit 2443

/Tonia LM Dollinger/

Supervisory Patent Examiner, Art Unit 2443